

REMARKS

Claims 1-4 are now pending in the present application. Claims 3 and 4 are directed to the elected invention. Claims 1 and 2 are drawn to the non-elected invention and may be cancelled by the Examiner upon allowance of the claims directed to the elected invention. Claim 3 has been amended to recite "wherein the cationic group-containing polymer has a number average molecular weight of not more than 3000." Support for this amendment can be found on page 12, lines 25-31 of the specification. This amendment does not introduce any new matter.

Claims 3 and 4 were rejected under 35 USC 102(e) as being anticipated by US Patent 6,312,727 to Schacht et al., or US Patent 6,974,698 to Miller et al. or obvious thereover under 35 USC 103(a). Schacht et al. and Miller et al fail to anticipate and fail to render obvious claims 3 and 4.

Schacht et al. and Miller et al., suggest conjugates using a cationic polymer. However, claims 3 and 4 as amended recite particular number average molecular weights that are not anticipated by the suggestions in the cited references of only a broad range. In the present claim 3, the number average molecular weight (Mn) of the cationic group-containing polymer is limited to "not more than 3000", and the cationic group-containing polymers having Mn of "not more than 3000" are used in Examples.

On the other hand, cationic polymers (poly(L-lysine)) referred to in Examples of Schacht et al. have a weight average molecular weight (Mw) of "20000 to 25000", and cationic polymers (PEI) referred to in Examples of Miller et al., have Mw of "80000". Generally, Mn is smaller than Mw, but the Mn of these cationic polymers are expected to be obviously "more than 3000." That is, these cited references disclosed nothing specifically with respect to the range that recites "not more than 3000", nor do they focus on the importance of such aspect.

The cited references fail to anticipate the present invention. In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. See *Scripps Clinic and Research Foundation v.*

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. *See Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

The law is well settled that claiming of a more specific range within a more generic range and/or claiming species from a broader group of possible compounds avoids a lack of novelty rejection. The test for anticipation is whether the claims read on the prior art disclosure, not on what the references broadly teach.

For example, see *Akzo N.V. v. U.S. International Trade Commissioner* 1 USPQ2d 1241 (Fed. Cir. 1986). In *Akzo*, claims that were drawn to a process for making aramid fibers using a 98% sulfuric acid were not anticipated by a reference using a concentrated sulfuric acid solution but which did not specifically disclose that it was a 98% concentrated sulfuric acid solution. The disclosure of a concentrated sulfuric acid was not deemed an inherent disclosure of the more specific 98% sulfuric acid.

The court further found that no anticipation exists when one would have had to “randomly pick and choose among a number of different polyamides, a plurality of solvents and a range of inherent viscosities” to reach the claimed invention.

Also see *In re Kollman et al.* 201 USPQ 193 (CCPA-1979) wherein the court held that the prior art generic disclosure contains “no suggestion of the required FENAC/diphenyl ether ratio”.

In Rem-Cru Titanium v. Watson 112 USPQ 88 (D.D.C-1956), the prior art showed alloys having broad ranges which included the claimed ranges. However, the prior art did not explicitly disclose the more limited claimed ranges or alloys having the characteristics of the claimed alloy, which is analogous to the present case. Accordingly, the court held the claims to be allowable. For a similar factual pattern and same holding, please see *Becket v. Coe* (CA, Dc 1938) 38 USPQ2d and *Tarak v. Watson* (DC-DC 1954) 103 USPQ 78.

Also, see *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Ortho-Paedics, Inc.* 24 USPQ2d 1321 (Fed. Cir 1992). Here the court held that although the claims may be subsumed in a prior art reference generalized disclosures, this is not literal identity. The references ranges were “so broad as to be meaningless” and provided no guidelines on how to construct a product with the invention’s attributes.

In addition, attached is Declaration under 37 CFR 1.132 containing experimental data which proves that when the conjugate formed by using the cationic group-containing polymer having Mn of "more than 3000" is used, the introduction efficiency actually decreases.

Accordingly, the present claims are patentable over the cited references.

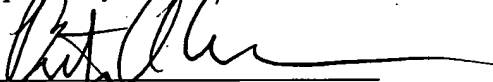
In view of the above amendment, applicant believes the pending application is in condition for allowance.

In the event that the Examiner believes that another interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

Please charge \$120.00 to our Deposit Account No. 22-0185, under Order No. 21581-00303-US from which the undersigned is authorized to draw.

Dated: 9-22-06

Respectfully submitted,

By 

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